REMARKS AND ARGUMENTS

Response to Rejection Under 35 U.S.C. § 102/103

Claims 1-4, 6-18, 20- 24 and 27-29 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C § 103(a) as obvious over *Wynne* (US 5,328,743). The Examiner states.

> Wynne teaches a reinforced shrink wrap that is mululayered with reinforcing grids in adhesive layers on either side of a shrink film with outer layers of olefin film (abstract). The shrink film layer is highly irradiated polyethylene and the preferred thickness is from 0.75 mil to 1.5 mils (col. 2, ln. 22-25). The outer layers of the shrink wrap is a polyolefin film from 1 to 6 mil thick and may have two plies or more (col. 2, ln 48-49 and 54). The polyolefin layers can include additives such as color additives, antioxidants, ultraviolet light stabilizers, and corrosion inhibitors (col. 3, ln. 15-22). In addition, additives used in polyolefin film may be included as desired in the polyolefin inner or outer layers or in one of more plies of a multiply film. Additives include ultraviolet light stabilizers and flame retardants (col 1, ln 52-58). The reinforcing grid is preferably 200 to 800 denier yarn in a crisscross pattern which the Examiner equates to be the non-woven scrim of Applicant's invention The grid is filamentous made of single strand or multiple filament yarn preferably nylon, polyester or blends (col 2, ln. 28-31). The reinforcing grid is in a layer of adhesive, which the Examiner equates to be the tie layer of Applicant's invention, that has a dry thickness of between 0.25 and 1 mil The adhesive should be used in an effecive amount to prevent delamination (col 2, ln. 31-36). There can be more than one adhesive layer (col. 4, ln 12-14). Inherently, the adhesive of Wynne et al. will have a lower modulus than the outer polyolefin layers since the adhesive is not used in an amount that retards the movement of the grid and because the grid sags to prevent tearing.
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> Applicant has amended the claims to read on an "extrusion-laminated" shrink wrap. Wynne et al. fail to disclose that the shrink wrap is extrusion-laminated. Wynne does disclose that the outer layers are co-extruded (col 5, ln 10-12 and ln 21-23). It should be noted that the method of forming an article is not germane to the issue of patentability of the article itself. Furthermore, it is not seen how extrusion laminating the shrink wrap significantly affects the chemistry or structure of the shrink wrap itself. It is the examiner's position that the shrink wrap of Wynne et al. is identical to or only slightly different than the claimed shrink wrap prepared by the method of the claims, because both shrink wrap comprise a first layer of thermoplastic material, a second layer of thermoplastic material, a reinforcing grid disposed between the first and second layers of thermoplastic and an adhesive of elastomeric material. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim in unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The Wynne et al. either anticipated or

> strongly suggested the claimed subject matter. In the event any difference can be shown for the shrink wrap of the product-by-process claims 1-4, 6-18, 20-24, and 27-29, as opposed to the product taught by the Wynne et al. reference, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results, see also *In re Thorpe*, 227 USPQ 964 (Fed Cir. 1985). Rejection is maintained

Office Action of April 24, 2003, pages 2-4.

The Applicants have considered the Examiner's reasons in view of the disclosure of Wynne and respectfully disagree. The Applicants reasons are stated as follows.

With regard to novelty, the Examiner states that Wynne et al fails to disclose that the shrink wrap is extrusion-laminated The examiner further states that the method of forming an article is not germane to the issue of patentability of the article itself. However, the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See,e g , *In re Garnero* ,412 F.2d 276,279,162 USPQ 221,223 (CCPA 1979), MPEP § 2113. The Applicant submits that the process limitation is a meaningful limitation.

The examiner has placed the burden on the Applicant to show how the process significantly affects the chemistry or structure of the shrink wrap itself. The extrusion-lamination process provides the shrink wrap with improved tensile properties including puncture strength and seam integrity. By stating the shrink wrap is extrusion laminated, different properties are assumed for the product than if the method of producing the shrink wrap were omitted. These improved properties were submitted to the Examiner in a declaration by Mr. Dennis J. Olheiser under 37 C F.R. § 1.132 filed in the parent application (serial number 09/263,186) on March 27, 2001. A copy of the declaration is enclosed. According to the declaration, the average peel strength of 5-ply shrink laminates with tie layers is about 70 oz., whereas the average peel strength of 5-ply shrink laminates with adhesive layers is about 25 oz., showing that the extrusion-laminated reinforced shrink wrap has a higher lamination strength than prior art shrink laminate. Therefore, the Applicant believes that the product produced by extrusion lamination is different from those in

the prior art which are not produced by extrusion lamination.

To rebut the obviousness rejection, the Applicant submits that before the invention was made, there existed a belief in the art that a shrink film could not be laminated with other layers in a typical extrusion lamination process. This is due to the concern that the processing conditions in a typical extrusion lamination process may cause the shrink film to shrink during the lamination process. In contrary to the conventional belief in the art, the Applicants found that shrink films can be laminated with other layers in an extrusion-lamination process under certain conditions. Therefore, the Applicants went against conventional wisdom and produced an extrusion-laminated reinforced shrink wrap with improved tensile properties. The totality of the prior art must be considered, and **proceeding contrary to accepted wisdom in the art is evidence of nonobviousness** (emphasis added) In re Hedges, 783 F 2d 1038, 228 USPQ 685 (Fed. Cir 1986) *See MPEP § 2145 X.* Furthermore, "[k]nown disadvantages in old devices which would naturally discourage search for new inventions may be taken into account in determining obviousness." United States v Adams, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966).

For these reasons, *Wynne* does not anticipate any of the pending claims. The Applicants further submit that *Wynne* does not render the pending claims obvious either. Consequently, all pending claims are patentable.

CONCLUSION

Applicants have addressed all of the Examiner's rejections. In conjunction with the claim amendments and arguments above, Applicants believe that the claims are now in condition for allowance and respectfully request that the Examiner grant such an action. If any questions or issues remain in the resolution of which the Examiner feels will be advanced by a conference with the Applicants' attorney, the Examiner is invited to contact the attorney at the number noted below.

No fees are due as a result of this Reply. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 10-0447, reference 41836.55USC1(BAI).

Respectfully submitted,
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